

REMARKS

This present case involves claims that were rejected during prosecution of the current application. Applicants ultimately appealed the rejections of the claims in the present application and received a Decision On Appeal dated April 11, 2008 (hereafter, 'the Board Decision'). In this decision, the Board of Patent Appeals and Interferences (hereafter, 'the Board') reversed all prior rejections but set forth new grounds of rejections against the claims of the present application. The following is a summary of the new grounds of rejection set forth by the Board:

- Claims 23-30, 50, and 51 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
- Claims 1 and 52 stand rejected under 35 U.S.C. § 102 as being anticipated by Gallick (U.S. Patent No. 6,678,359) (hereafter, 'Gallick').
- Claims 1, 2, 4, 8, 11-13, 15, 19, 22-24, 26, 30, 40, 41, 43-45, 46, and 48-51 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gallick in view of Bartholomew, et al. (U.S. Patent No. 6,167,119) (hereafter, 'Bartholomew').
- Claims 3, 14, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gallick, Bartholomew, and McAllister (U.S. Patent No. 6,101,242) (hereafter, 'McAllister').
- Claims 9 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gallick, Bartholomew, and Baker (U.S. Patent No. 5,533,109) (hereafter, 'Baker').
- Claims 10 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gallick, Bartholomew, and La Porta, et al. (U.S. Patent No. 6,041,103) (hereafter, 'La Porta').

Applicants present the following remarks indicating that the amended claims of the present application are in condition for allowance.

Claims Amendments

In an effort to move this case forward, Applicants presently amend independent claims 1, 12, 23, 40, 45, and 50 to include allowable subject matter as identified in previous Office Actions. In the Office Action dated November 4, 2005 (hereafter, ‘the Office Action’), claims 5-7, 16-18, 27-29, 42, and 47 were identified as reciting allowable subject matter. The Office Action at page 10 stated that claims 5-7, 16-18, 27-29, 42, and 47 were objected to “but would be allowable if rewritten in independent form.” In an Examiner’s Answer dated June 5, 2007 (hereafter, ‘the Examiner’s Answer’), at pages 10-11, claims 5-7, 16-18, 27-29, 42, and 47 were again identified as reciting allowable subject matter.

Applicants presently amend independent claims 1, 12, 23, 40, and 45 to include limitations previously found in claims 5, 16, 19, 27, 42, and 47, which were identified as reciting allowable subject matter in the Office Action and the Examiner’s Answer. Furthermore, Applicants amend claim 50 to include limitations previously found in claim 51 – limitations that correspond to the limitations recited in claims 5, 16, 19, 27, 42, and 47. As such, Applicants presently cancel claims 5, 16, 19, 27, 42, 47, and 51 in this Submission. In amending the claims in the present application, Applicants do not concede that the claims as originally filed were not in a condition for allowance. Rather, Applicants reserve the right to pursue the originally filed claims in one or more continuation or divisional applications.

Claim Rejections – 35 U.S.C. § 101

The Board set forth new grounds of rejection in a decision rendered on April 11, 2008. In that decision the Board rejected claims 23-30, 50, and 51 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, stating at page 12:

The specification indicates that “computer readable media include recordable type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and *transmission-type media, such as digital and analog communication links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions*”

That is, the Board takes particular issue with the Applicants’ inclusion of ‘transmission-

type media’ as a form of computer readable media. The Board takes the position that such transmission-type media is non-statutory in view of the Federal Circuit’s holding *In re Nuijten*. In response to the Board’s Decision, Applicants amend claims 23 and 50 in this Submission to include the limitation ‘wherein the recording medium is a recordable-type media.’ Because Applicants presently amend claims 23 and 50 of the present application to exclude transmission-type media as a form of claimed computer readable media, Applicants respectfully submit that the claims as presently amended satisfy all requirements of 35 U.S.C. § 101. As such, the rejection claims 23 and 50 under 35 U.S.C. § 101 should be withdrawn and claims 23 and 50 should be allowed.

Relations Among Claims

Dependent claims 24-30 depend from independent claim 23. Each dependent claim includes each and every element and limitation of the claim from which it depends. For the same reasons that amended independent claim 23 now recites statutory subject matter within the meaning of 35 U.S.C. § 101, dependent claims 24-30 also recite statutory subject matter within the meaning of 35 U.S.C. § 101. The rejection of claims 24-30 under 35 U.S.C. § 101 should therefore be withdrawn and the claims should be allowed.

Claim Rejections – 35 U.S.C. § 102 over Gallick

The Board of Patent Appeals and Interferences set forth new grounds of rejection in a decision rendered on April 11, 2008. In that decision the Board rejected claims 1 and 52 as being anticipated by Gallick. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As presently amended, claims 1 and 52 are amended to include limitations previously found in claim 5 of the present application – limitations identified in a previous Office Action and Examiner’s Answer as reciting patentable subject matter. Furthermore, Applicants respectfully note that the Board Decision rendered in the present case set forth

no rejections of claim 5 in the present application. As such, claims 1 and 52 as presently amended recite subject matter that has been identified as allowable and subject matter which the Board did not identify as being unpatentable. The rejection of claims 1 and 52 should be withdrawn and the claims should be allowed.

Claim Rejections – 35 U.S.C. § 103 over Gallick and Bartholomew

The Board of Patent Appeals and Interferences set forth new grounds of rejection in a decision rendered on April 11, 2008. In that decision the Board rejected claims 1, 12, 23, 40, 45, and 50 under 35 U.S.C. § 103 as being unpatentable over Gallick in view of Bartholomew. The question of whether Applicants' claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a *prima facie* case of obviousness to reject Applicants' claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a *prima facie* case of obviousness, the proposed combination of the references must teach or suggest all of the claim limitations of dependent claims 1, 12, 23, 40, 45, and 50. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

In this Submission, claims 1, 12, 23, 40, 45, and 50 are amended to include limitations previously found in claims 5, 16, 27, 42, 47 of the present application – limitations identified in the Office Action and the Examiner's Answer as reciting patentable subject matter. Furthermore, Applicants respectfully note that the Board Decision rendered in the present case set forth no rejections of claims 5, 16, 42, 47 in the present application. The Board of Patent Appeals and Interferences decision did set forth a rejection of claim 27 under 35 U.S.C. § 101 – a rejection that has been cured by an amendment in this Submission. As such, claims 1, 12, 23, 40, 45, and 50 as presently amended recite subject matter that has been identified as allowable and subject matter that the Board did

not identify as being unpatentable. The rejection of claims 1, 12, 23, 40, 45, and 50 should be withdrawn and the claims should be allowed.

Relations Among claims

Claims 2, 4, 8, 11, 13, 15, 19, 22, 24, 26, 30, 41, 43-44, 46, and 48-49 depend from claims 1, 12, 23, 40, 45, and 50. Each dependent claim includes each and every element and limitation of the independent claim from which it depends. For the same reasons that the amended independent claims of the present application are patentable over the combination of Gallick and Bartholomew, the dependent claims of the present application are also patentable over the combination of Gallick and Bartholomew. As such, claims 2, 4, 8, 11, 13, 15, 19, 22, 24, 26, 30, 41, 43-44, 46, and 48-49 are therefore patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103 over some combination of Gallick, Bartholomew, McAllister, Baker, and LaPorta

The Board of Patent Appeals and Interferences set forth new grounds of rejection in a decision rendered on April 11, 2008. In that decision the Board rejected claims 3, 9, 10, 14, 20, 21, and 25 under 35 U.S.C. § 103 as being unpatentable over a combination of Gallick, Bartholomew, McAllister, Baker, and LaPorta. In rejecting claims 3, 9, 10, 14, 20, 21, and 25, the Board relied upon the combination of Gallick and Bartholomew as teaching or suggesting each and every element and limitation of claims 1, 12, and 23. As shown above, the combination of Gallick and Bartholomew does not teach or suggest each and every element and limitation of claims 1, 12, and 23 as amended in this Submission. Because the combination of Gallick and Bartholomew does not teach or suggest each and every element and limitation of amended independent claims 1, 12, and 23, no combination of Gallick, Bartholomew, McAllister, Baker, and LaPorta can teach or suggest each and every element and limitation of dependent claims 3, 9, 10, 14, 20, 21, and 25. The rejection of claims 3, 9, 10, 14, 20, 21, and 25 under 35 U.S.C. §103 should therefore be withdrawn and the claims should be allowed.

Conclusion

Claims 23-26, 28-30, and 50 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As shown above, claims 23-26, 28-30, and 50 as currently amended now recite statutory subject matter within the meaning of 35 U.S.C. § 101. The rejection of claims 23-26, 28-30, and 50 under 35 U.S.C. § 101 should therefore be withdrawn and the claims should be allowed. Applicants respectfully request reconsideration of claims 23-26, 28-30, and 50.

Claims 1 and 52 stand rejected under 35 U.S.C. § 102 as being anticipated by Gallick. As shown above, Gallick does not disclose each and every element and limitation of claims 1 and 52. The rejection of claims 1 and 52 under 35 U.S.C. § 102 should therefore be withdrawn and the claims should be allowed. Applicants respectfully request reconsideration of claims 1 and 52.

Claims 1, 2, 4, 8, 11-13, 15, 19, 22-24, 26, 30, 40, 41, 43-45, 46, and 48-51 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gallick in view of Bartholomew. As discussed above, the combination of Gallick and Bartholomew does not teach or suggest each and every element and limitation of Applicants' claims. The rejection of Applicants' claims under 35 U.S.C. § 103 should therefore be withdrawn and the claims should be allowed. Applicants respectfully request reconsideration of claims 1, 2, 4, 8, 11-13, 15, 19, 22-24, 26, 30, 40, 41, 43-45, 46, and 48-51.

Claims 3, 9, 10, 14, 20, 21, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over a combination of Gallick, Bartholomew, McAllister, Baker, and La Porta. As discussed above, no combination of Gallick, Bartholomew, McAllister, Baker, and La Porta teaches or suggests each and every element and limitation of Applicants' claims. The rejection of Applicants' claims under 35 U.S.C. § 103 should therefore be withdrawn and the claims should be allowed. Applicants respectfully request reconsideration of claims 3, 9, 10, 14, 20, 21, and 25.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: June 3, 2008

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